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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,834	11/23/2002	Dante Monteverde	33983/400300	9663
27717	7590	02/16/2005	EXAMINER	
SEYFARTH SHAW 55 EAST MONROE STREET SUITE 4200 CHICAGO, IL 60603-5803			OSBORNE, LUKE R	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/065,834	<b>Applicant(s)</b> MONTEVERDE, DANTE	
	<b>Examiner</b> Luke Osborne	<b>Art Unit</b> 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/23/02, 5/28/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because Figure 6 contains hand drawn and hand written contents and reference characters and is found to be non compliant with 37 CFR 1.84 (l) and (p). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "most" in the last two paragraphs of claim 1 is a relative term, which renders the claim indefinite. The term "most" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Regarding claim 6, it is not clear how the method can "subjectively" determine as recited.

Claim 8 depends upon itself and is therefor improper. Appropriate correction is required. In the interest of a compact prosecution the Examiner presumes Claim 8 to depend upon Claim 7.

The art rejections of claims 1-8 are applied as best understood in light of the rejection under 112, 2<sup>nd</sup> paragraph discussed above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-8 rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent 6,704,729 to Klein et al. hereafter "Klein".

Regarding claim 1, Klein teaches a method of determining relevant search results for an Internet based search query having at least one search term. See figures 1B, 4, 8 and the corresponding portions of Klein's specification for this teaching. In particular, Klein teaches "A method of determining relevant search results for an Internet based search query having at least one search term, the method comprising the steps of:

- providing a topical category database having a plurality of topical categories [Column 7, line 64 – Column 8, line 21, Figure 4, item 404];
- providing an Internet site database having Internet site information for at least one Internet site, each of the Internet sites having content [Column 8, lines 34-55];

- assigning each of the Internet site informations in the Internet site database to at least one of the topical categories in the topical category database thereby creating assigned Internet sites [Column 3, lines 9-12];
- providing a search term database having at least one search term, each of the search terms having a definition [Column 3, lines 45-60];
- assigning each of the search terms in the search term database to at least one of the topical categories in the topical category database thereby creating a search term assignment [Figure 1B, Column 3, line 62 – Column 4, line 21];
- receiving at least one initial search term [Column 7, line 64 – Column 8, line 21];
- matching the initial search term with at least one of the search terms in the search term database thereby creating a matched search term [Column 8, lines 34-55];
- associating the initial search term with the topical categories that the matched search term is assigned to thereby creating associated topical categories [Column 3, lines 45-60];
- determining a most relevant associated topical category from the associated topical categories [Column 10, line 34 – Column 11, line 10]; and
- retrieving the Internet site information for each of the assigned Internet sites assigned to the most relevant associated topical category [Column 4, lines 17-25, Figure 1B, Figure 8]” as claimed.

Regarding claim 2, Klein teaches the method as claimed in claim 1 “wherein each of the topical categories is defined with a title and description [Column 8, lines 10-12]” as claimed.

Regarding claim 3, Klein teaches the method as claimed in claim 1 “wherein the step of assigning each of the search terms in the search term database to at least one of the topical categories in the topical category database thereby creating a search term assignment comprises assigning each of the search terms to a topical category based on the definition [Column 7, line 64 – Column 8, line 21]” as claimed.

Regarding claim 5, Klein teaches the method as claimed in claim 1 “wherein the step of determining a most relevant associated topical category from the associated topical categories comprises calculating the number of times the search term is repeated within the content of the assigned Internet sites assigned to each of the associated topical categories [Column 8, line 55 – Column 9, 54]” as claimed.

Regarding claim 6, Klein teaches the method as claimed in claim 1 “wherein the step of determining a most relevant associated topical category from the associated topical categories comprises subjectively determining the most relevant associated topical category [Column 9, line 55 – Column 10, line 21]” as claimed.

Regarding claim 7, Klein teaches the method as claimed in claim 1 "wherein the step of retrieving the Internet site information for each assigned Internet site assigned to the most relevant associated topical category comprises the step of organizing the assigned Internet sites in a logistical order [Column 12, lines 36-41]" as claimed.

Regarding claim 8, Klein teaches the method as claimed in claim 8 "wherein the step of organizing the assigned Internet sites in a logistical order further comprises organizing the assigned Internet sites based upon statistical information [Column 13, lines 9-20, Column 9, line 55 – Column 10, line 2]" as claimed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,704,729 to Klein et al. in view of U.S. Patent No. 6,647,383 to August et al. hereafter "August".

Regarding claim 4, Klein teaches the method as claimed in claim 1 but, does not expressly teach that the step of determining a most relevant associated topical category



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from the associated topical categories comprises calculating the number of times each said associated topical category is selected by other searchers in association with the initial search term.

August teaches a method similar to Klein and further teaches that the step of determining a most relevant associated topical category from the associated topical categories comprises calculating the number of times each said associated topical category is selected by other searchers in association with the initial search term [August: Column 8, lines 42-52].

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to calculate the number of times each said associated topical category is selected by other searchers in association with the initial search term.

The motivation for doing so would have been to enable the system to quantify the traffic and therefore the importance of a URL [August: Column 8, lines 42-52]

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Osborne whose telephone number is (571) 272-4027. The examiner can normally be reached on 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LRO  
2/14/05



**UYEN LE**  
**PRIMARY EXAMINER**